



Paper No. 23

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OFFICE OF PETITIONS

In re Application of
Cheryl D. Senter, Johannes Wang,
Le Trong Nguyen, Derek J. Lentz,
Yoshiyuki Miyayama, Sanjiv Garg,
Yasuaki Hagiwara, Te-Li Lau,
Sze-Shun Wang and Quang H. Trang
Application No. 09/336,589
Filed: June 21, 1999
Attorney Docket No. SP036.C5

DECISION GRANTING PETITIONS
UNDER § 1.48(c) and § 1.183

This is a combined decision on the three petitions filed June 18, 2002: 1) Request to Add Inventors in a Nonprovisional Patent Application Under 37 C.F.R. § 1.48(c); Petition for Waiver Under 37 C.F.R. § 1.183 of the Requirement under § 1.48(c)(2) of Statements by Persons Being Added as an Inventor; and a Petition under 37 C.F.R. § 1.47, which is properly treated as a Petition under § 1.183 to waive the Requirement under § 1.48(c)(3) for execution of the declaration by all of the actual inventors. Petitioner has submitted a check for \$390, which covers the processing fees for consideration of the petitions. These petitions were considered in light of the additional evidence provided by facsimile transmission on October 4, 2002 and October 7, 2002.

The above-identified application was filed on June 21, 1999, with a declaration executed by Cheryl Senter and Johannes Wang as joint inventors. On June 18, 2002, the instant request under § 1.48(c) was filed to amend the inventorship to add joint inventors Le Trong Nguyen, Derek J. Lentz, Yoshiyuki Miyayama, Sanjiv Garg, Yasuaki Hagiwara, Te-Li Lau, Sze-Shun Wang and Quang H. Trang. Accompanying the petition was a statement from added inventor Miyayama stating that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention; and a declaration executed by actual inventors Senter and Miyayama.

37 CFR 1.48(c) requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Petitioner has satisfied requirements (1), (4) and (5) above. The petition specifically requests the addition of the above-identified inventors. Petitioner has paid the processing fee. The petition includes a statement signed by a person who states that they are empowered to act on behalf of the assignee and that they consent to the change in inventorship. Accompanying the assignee statement is a certificate under 37 C.F.R. § 3.73(b).

Petitioner requests waiver of the requirement for statements from the other added inventors on the basis that they are all unavailable. Likewise, petitioner requests waiver of the requirement that all of the inventors sign the declaration on the basis that petitioner has been unable to find or reach each of these inventors after a diligent effort. In support thereof, petitioner has provided a statement of facts by attorney Thomas Fiala and documentary evidence of the inventors' unavailability.

Under 37 C.F.R. § 1.183, any requirement of the regulations, which is not a requirement of the statutes, may be waived by the Commissioner's designee in an extraordinary situation, when justice so requires. Waiver of both requirements is appropriate in this instance. The facts of the record do not present uncertainty as to this correction of inventorship. The assignee has given consent to the requested correction. The petition shows that the statement was presented to the inventors and by their conduct they refused to sign it. Petitioner has shown that each of the nonsigning inventors was actually given the opportunity to reexecute the oath or declaration, or could not be reached, after diligent effort. See MPEP 201.03.

Accordingly, both petitions under § 1.183 are GRANTED.

In view thereof, the petition under § 1.48(c) is GRANTED.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Telephone inquiries related to this decision may be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

(Christina Fiala) Donnell for

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for Patent Examination Policy